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10/592,019

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EXAMINER

MAZUMDAR, SONYA

ART UNIT

PAPER NUMBER

1791

NOTIFICATION DATE

DELIVERY MODE

09/29/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/592,019 | Applicant(s) ZACCHE ET AL. | |
| | Examiner SONYA MAZUMDAR | Art Unit 1791 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 1-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/7/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, as stated in claim 3, “providing stopper members secured to a bracket that can be moved according to two Cartesian axes in order to approach or move away from the drum axis to be vertically moved according to an axis parallel to the drum axis” must be shown or the features canceled from the claim. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: in line 12 of page 3, “racket” should be changed to “bracket”.

Appropriate correction is required.

Claim Objections

3. Claim 1 through 7 are objected to because of the following informalities:

In line 5 of claim 1 and line 1 of claims 2 through 7, “characterised” should be changed to “characterized”.

Claims 6 and 7 include reference numerals to the drawings in the application. However, to maintain consistency, all claims should either include or exclude use of reference numerals to the drawings.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for manually replacing label positioning devices (i.e. stopper), that are secured by vertical pins to a drum, when bottle formats change (page 3, lines 2-5), does not reasonably provide enablement for providing stopper members secured to a bracket that can be moved forward or away from the drum axis and to be vertically moved according to an axis parallel to the drum axis. It is unclear to one of

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ordinary skill in the art as to how a stopper, as shown in Figures 4-6 in Applicant's specification, moves apart from a drum axis, without manual intervention with the stopper and removal the vertical pins. One would predict that the stopper would move along with the drum to place or remove bottles from being labeled.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims, nor are there any examples disclosed to guide one of ordinary skill in the art.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 through 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 1 recites the limitations "the lower label edge" in line 5, "the tubular label winding drum" in line 7, and "the bottle transfer step" in line 8. There is insufficient antecedent basis for these limitations in the claim.

9. In line 5 of claim 1, the claim refers to "it", but it is unclear what is being referred to. Examiner is interpreting "it" as the claimed drum.

10. Claim 2 recites the limitation "the bottle supporting drum base" in line 1. There is insufficient antecedent basis for these limitations in the claim.

11. Claim 4 recites the limitation "the final heat-shrinking step" in line 4. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, 2, 6, and 7 are rejected under 35 U.S.C. 102(b) as being unpatentable by Eder (US 4,594,123).

With respect to claims 1 and 2, Eder teaches a device for positioning a tubular label at a pre-established height from a bottle bottom in a rotating labeling machine of a type equipped with:

- a drum (7) around which a tubular label (2) is formed, adapted to support the bottle to be labeled on an upper base, the drum being able to vertically translate in order to take the bottle inside the formed tubular label (column 3, lines 49-63; Figure 3),
- the drum provides lugs (i.e. stopper members) (27) placed in a semi-circle at a pre-established height from the bottle bottom when the bottle is housed on the tubular label winding drum (Figures 1 and 4), the semi-circle diameter having to be such as to allow the vertical bottle translation in applying the label to the bottle (column 2, lines 27-34; column 7, lines 36-52).

With respect to claim 6, Eder teaches providing projecting lugs (i.e. stopper members) (27), which inherently comprise vertically-oriented walls, arranged as a semi-circle on a collar (9) adapted to be secured to the upper base of the winding drum (9).

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With respect to claim 7, Eder teaches providing vertical pins (27) and screws that support a semi-circle bracket (34) on which gears (i.e. limit switches) (33) are radially secured, said vertical pins being able to be fixed to the upper base of the winding drum or to a bracket equipped with rotation and vertical movements (column 5, lines 22-44; column 7, lines 29-35).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eder ('123) as applied to claim 1 above, and further in view of Eder (US 5,464,495).

The teachings of claim 1 are as described above.

Eder ('123) does not teach supplying hot air jets from when it is labeled to a conveyor during heat-shrinking (Applicant's specification: page 3, line 23 – page 4, line 2). However, it would have been obvious for one having ordinary skill in the art to do so to assist in adhering a label, as Eder ('495) teaches supplying hot air through nozzles (67, 68, 69) during heat shrinking labels to bottles (1) while rotating on a star turntable (61) (column 12, line 41 – column 13, line 9; Figures 13-15).

18. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eder ('123) in view of Eder (US '495), as applied to claim 4 above, and further in view of Dullinger (US 3,784,438).

The teachings of claim 1 are as described above.

Eder ('123) does not retaining bottles in position on a star conveyor with elastic members. However, it would have been obvious for one having ordinary skill in the art to do so, as Dullinger teaches providing rubber padding to allow conformance and engagement of the bottles in the conveyor (abstract; column 1, lines 55-57; column 3, lines 32-35).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SONYA MAZUMDAR whose telephone number is (571)272-6019. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SM

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791